

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)									
		17065/004001									
		Application Number	Filed								
		10/656,687-Conf. #8553	September 5, 2003								
		First Named Inventor									
		James Alfred Thompson									
		Art Unit	Examiner								
		2423	J. O. Mendoza								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tbody><tr><td><input type="checkbox"/> applicant /inventor.</td><td>_____ /Robert P. Lord/ Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>_____ Robert P. Lord Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 46,479</td><td>_____ (713) 228-8600 Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</td><td>_____ December 1, 2010 Date</td></tr></tbody></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p>				<input type="checkbox"/> applicant /inventor.	_____ /Robert P. Lord/ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	_____ Robert P. Lord Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 46,479	_____ (713) 228-8600 Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	_____ December 1, 2010 Date
<input type="checkbox"/> applicant /inventor.	_____ /Robert P. Lord/ Signature										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	_____ Robert P. Lord Typed or printed name										
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 46,479	_____ (713) 228-8600 Telephone number										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	_____ December 1, 2010 Date										

22511

PATENT TRADEMARK OFFICE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

In re Patent Application of:  
James Alfred Thompson

Confirmation No.: 8553

Application No.: 10/656,687

Art Unit: 2423

Filed: September 5, 2003

Examiner: J. O. Mendoza

For: CABLE NETWORK ACCESS CONTROL  
SOLUTION

---

MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Authority**

Applicants' claims have been rejected at least twice, so filing a Notice of Appeal with proper fee and a pre-appeal brief request for review is proper. *See*, 35 USC § 134.

**Remarks**

**A. The Examiner has failed to properly consider the probative value of the declarations**

MPEP § 716.01(d) states that “[i]n assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986).” A detailed discussion of the evidence supporting the Applicant's assertion of secondary considerations may be found in the Declaration of Robert Shugarman (“Shugarman Declaration”), Declaration of Robert V. Moel (“Moel Declaration”), Declaration of Terry Paul (“Paul Declaration”), Declaration of James A. Wolsiffer (“Wolsiffer Declaration”), and in the Response to the Office Action dated

March 3, 2010, previously submitted on October 15, 2009, and July 9, 2010. The previously submitted declarations have been entered and reviewed by the Examiner, and as such, they are part of the file wrapper for the referenced application.

In the Office Action dated August 2, 2010 (“Action”), the Examiner asserts that the previously submitted declarations are insufficient because “the pertinent prior art references seek to solve the same problem as the current application.” Action, page 2. However, the Examiner’s analysis is completely silent with respect to the probative value of the evidence in the declarations. Specifically, the Examiner fails to consider the strength of any opposing evidence, the interest of the expert, and the presence or absence of factual support. Instead, the Examiner disregards the evidence presented in the previously submitted declarations because the prior art purportedly solves the same problem. In other words, the Examiner fails to properly weigh the evidence presented on both sides of the matter sought to be established by the declarations. In view of the above, Applicants respectfully assert that the Examiner has failed to properly consider the probative value of the evidence in the previously submitted declarations as required by MPEP § 716.01(d).

**B. The Examiner has failed to properly establish that the rebuttal evidence is insufficient**

Pursuant to MPEP §§ 716.04 and 2145, in order to establish long-felt need and failure of others, the Applicant must show evidence that (1) “the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967);” (2) “the long-felt need has not have been satisfied by another before the invention by Applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988);” and (3) “the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971)<sup>1</sup>.” MPEP § 716.04.

---

<sup>1</sup> There must be a nexus between the rebuttal evidence and the claimed invention, *i.e.*, objective evidence of nonobviousness must be attributable to the claimed invention. *See* MPEP § 2145.

In the previously submitted declarations, Applicants assert that the claimed invention has at least the following additional capabilities over the prior art solutions: (i) providing functionality to remotely authorize access to the Cable Distribution Box; (ii) providing functionality to enable unlocking on the Cable Distribution Boxes after remote authorization has been granted; (iii) providing functionality to track access to the Cable Distribution Boxes using a work log, which may be remotely accessed; (iv) incorporating an internal locking mechanism, which removes external failure points of the locking mechanism used to secure the RSS Cable Distribution Boxes; and (iv) configuring the Cable Distribution Boxes to be solely powered using power from the coaxial cable line. See Shugarman Declaration, items 14, 16; Moel Declaration, items 16, 17; Paul Declaration, items 17, 19; Wolsiffer Declaration, items 20, 22. In other words, the previously submitted declarations clearly describe the problems associated with *physical locks* that are solved by the claimed invention.

In the Action, the Examiner, in articulating the analysis used to reject the claims under 35 U.S.C. §103, asserts that the previously submitted declarations are insufficient because “the pertinent prior art references seek to solve the same problem as the current application.” Action, page 2. Specifically, the Examiner asserts that various locking mechanism disclosed in U.S. Patent No. 4,502,609 (“Christatos”), U.S. Patent No. 3,812,279 (“Voegeli”), and U.S. Patent No. 4,626,616 (“Masters”) seek to solve the same problem as the present invention. The Examiner then concludes by asserting that “the existence of prior art references showing a solution to the same problem being solved by the current application is evidence that there is no long-felt need.” Action, page 3. However, Applicants assert that the Examiner has failed to provide sufficient evidence that the cited prior art solve the same problem as the present invention.

The Examiner asserts that disclosure of various physical lock and key mechanisms for securing a lockbox solve the same problem as the present invention. *See* Action at pages 2-3. In contrast, the previously submitted declarations provide evidence that a physical lock and key mechanisms as described in the cited prior art fail to prevent unauthorized access to the lockbox. Specifically, the declarations state that legacy lockboxes fail to prevent theft because (1) the legacy lockboxes are physically compromised by unauthorized parties; (2) the legacy lockboxes are accidentally left open by authorized personnel and then subsequently accessed by the unauthorized parties; and (3) keyed locks of legacy lockboxes are easily duplicated, allowing former contractors and employees to have unauthorized access. *See* Shugarman Declaration, item 11; Moel Declaration, item 12; Paul Declaration, items 12; Wolsiffer Declaration, item 16. The Examiner has failed to provide any evidence regarding how the cited prior art addresses each of the aforementioned problems of legacy lockboxes.

In fact, the prior art references relied upon by the Examiner all disclose locking *mechanisms* that are opened by *physical* keys. *See* Christatos, FIG. 2 and column 4 at lines 48-55; Voegeli, FIG. 7 and column 2 at lines 42-45; Masters, FIG. 4 and column 4 at lines 20-27. Thus, the cited prior art cannot solve, at least, the aforementioned problems of (1) accidental failures to secure the legacy lockboxes allowing unauthorized access and (2) duplicate keys allowing former contractors and employees to have unauthorized access. In view of the above, Applicants respectfully assert that the Examiner has failed to properly demonstrate that the rebuttal evidence is insufficient to establish a long-felt need and failure of others.

**C. The Examiner has failed to properly weigh the rebuttal evidence against the prima facie case of obviousness**

MPEP § 716.01(d) states that “[a]ll of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case [of obviousness].” As

discussed above, the Examiner has failed to properly demonstrate that the rebuttal evidence is insufficient to establish a long-felt need and failure of others. In the Action, the Examiner only asserts that the rebuttal evidence is insufficient to establish a long-felt need and failure of others. However, the Examiner's fails to evaluate the rebuttal evidence in view of the prima facie case of obviousness. *See* MPEP § 716.01(d) ("Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached"). Thus, Applicants respectfully assert that the Examiner has failed to properly consider the rebuttal evidence and that his contentions do not support the rejection of claims 1, 3-15, 18, 19, 21-27, and 30-39 under 35 U.S.C. § 103.

#### **D. Conclusion**

In view of the above, the Examiner's contentions do not support the rejection of claims 1, 3-15, 18, 19, 21-27, and 30-39 under 35 U.S.C. § 103. Accordingly, a favorable decision from the panel is respectfully requested. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 17065/004001).

Dated: December 1, 2010

Respectfully submitted,

By /Robert P. Lord/  
Robert P. Lord  
Registration No.: 46,479  
OSHA · LIANG LLP  
909 Fannin Street, Suite 3500  
Houston, Texas 77010  
(713) 228-8600  
(713) 228-8778 (Fax)  
*Attorney for Applicant*